

Remarks:

Reconsideration of the application is requested.

Claims 1-4 remain in the application.

In item 1 on page 2 of the above-identified Office action, the Examiner stated that the information disclosure statement filed November 21, 2001 fails to comply with 37 CFR 1.98 (a)(3), and therefore the information contained therein has not been considered. Enclosed herewith is a further IDS with the corresponding English language documents along with the fee in the amount of \$180. Please charge any other fees due to Deposit Account of Lerner & Greenberg P.A., No. 12-1099

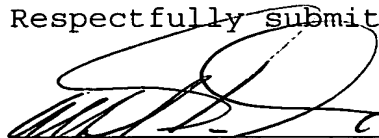
In item 3 on page 2 of the Office action, claims 1 and 2 have been rejected as being obvious over Kipphan et al. (U.S. Patent No. 5,031,535) (hereinafter "Kipphan") in view of Schramm et al. (U.S. Patent No. 4,200,932) (hereinafter "Schramm") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

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Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



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Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

deriving presetting values for zonal ink metering devices and for ink metering rollers acting over a printing width from a set value for a weight per unit area of a full tone area.

It is noted that the corporate assignee of the Kipphan and the Kipphan et al. references is also the corporate assignee of the instant application, and therefore, applicants are very familiar with the Kipphan and Kipphan et al. references.

It is respectfully noted that the Examiner's comments on page 3 of the Office action, that deriving presetting values for zonal ink metering devices and for an ink metering roller acting over a printing width, form a set value for a weight per unit area (density) of a full tone area, are not accurate.

The Examiner correctly stated in the first paragraph of page 3 of the Office action, that Kipphan does not teach a derivation of presetting values for zonal ink metering devices and for ink metering rollers acting over a printing width from a set value for a weight per unit area of a full tone area.

The Examiner has incorrectly interpreted how the term "weight per unit area" in claim 1 of the instant application is to be understood. It is explicitly stated in the specification of the instant application, that the weight per unit area is determined as the amount of ink per printed full tone area or solid ink area (page 4, lines 15-16) and that the weight per unit area G corresponds to the mass of the printing ink 2 per unit area of the test print (page 9, lines 15-16). Based on this it is absolutely clear that "weight" is defined in its ordinary sense related to gravitational forces. In other words, weight relates to a force that has units of Newtons (N). Therefore, "weight per unit area" as recited in claim 1 of the instant application, is a quantity with the units of Newtons per square meter ( $N/m^2$ ). If the Examiner believes it is necessary for allowance of claim 1, this clarification can be added to the claim.

The Schramm reference discloses a color density. The color density does not have the units of  $N/m^2$  and therefore cannot be identified as "weight per unit area", as the Examiner incorrectly has done. Furthermore, a person of ordinary skill in the art cannot find any teaching in Schramm that starting from color density, the "weight per unit area" can be inferred. There is no technical teaching in Schramm pertaining to the mass or weight of the printing ink.

The reference does not show deriving presetting values for zonal ink metering devices and for ink metering rollers acting over a printing width, from a set value for a weight per unit area of a full tone area, as recited in claim 1 of the instant application.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999).

Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the

whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

Broad conclusory statements standing alone are not "evidence."

Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 1 is believed to be allowable, dependent claim 2 is believed to be allowable as well.

In item 4 on page 3 of the Office action, claim 3 has been rejected as being obvious over Kipphan (U.S. Patent No. 5,031,535) in view of Schramm (U.S. Patent No. 4,200,932) and further in view of Kipphan et al. (U.S. Patent No. 6,041,708) under 35 U.S.C. § 103. Kipphan et al. do not make up for the deficiencies of Kipphan and Schramm. Since claim 1 is believed to be allowable, dependent claim 3 is believed to be allowable as well.

In item 5 on page 4 of the Office action, claim 4 has been rejected as being obvious over Kipphan (U.S. Patent No.

5,031,535) in view of Schramm (U.S. Patent No. 4,200,932) and further in view of Maier et al. (U.S. Patent No. 5,170,711) under 35 U.S.C. § 103. Maier et al. do not make up for the deficiencies of Kipphan and Schramm. Since claim 1 is believed to be allowable, dependent claim 4 is believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-4 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.